

SEP 9 1941
DEPT. OF JUSTICE

In the
Supreme Court of the United States.

OCTOBER TERM, 1941.

No. 332.

THE WILLIAMS MANUFACTURING COMPANY,
Petitioner,

v.

UNITED SHOE MACHINERY CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR CERTIORARI.

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STATEMENT OF THE CASE.

This is an ordinary patent suit brought by respondent against petitioner in the District Court for the Southern District of Ohio, for infringement of McFeely patent No. 1,558,737 and Hoyt patent No. 1,508,394. The District Court found both patents valid and infringed (Rec. Vol. I, p. 477). The Circuit Court of Appeals for the Sixth Circuit affirmed the holding of validity and infringement as to the McFeely patent but held the Hoyt patent invalid, Judge Hamilton dissenting without opinion (Rec. Vol. I, p. 502).

The charge of infringement was based upon petitioner's

Emphasis in this brief ours.

use of four so-called "Calzera" automatic heel seat lasting machines imported by petitioner from Germany, where they were made by Moenus Maschinenfabrik A/G of Frankfort. The Circuit Court of Appeals found that these German machines "are copies of the commercial construction of the plaintiff [respondent]" (Opinion, Rec. Vol. I, p. 505).

In its petition for certiorari and brief, petitioner asserts (p. 1) that "the issue here is the extent of the right to re-patent an expired monopoly". There is no such issue. An "expired monopoly" obviously cannot be "repatented". Both courts below specifically held that there was no such "repatenting". Petitioner is merely seeking to obtain from this court a third consideration of issues of fact which have been thoroughly considered and decided adversely to it by both of the courts below.

There is here no conflict of decision between Circuit Courts of Appeals, no new or doubtful question of law, no conflict between the decision of the Circuit Court of Appeals and applicable decisions of this or any other court, and no question of public importance.

All of the questions presented by the petition will be found, upon analysis, to be purely and simply *questions of fact*.

ALLEGED "EXTENSION OF EXPIRED MONOPOLY".

This is the "issue" to which the petition and brief are very largely devoted. Petitioner asserts that the decision of the Circuit Court of Appeals herein conflicts with the decisions of this Court in *Bassick v. Hollingshead*, 298 U.S. 415 and *Lincoln v. Stewart-Warner*, 303 U.S. 545, cited as prohibiting the extension of a monopoly of an expired patent by the substitution of mechanical details old in the art (Petition, p. 5; Br. p. 10).

The Circuit Court of Appeals was entirely familiar with the principle of these cases. The Court itself cited and discussed them, and in fact *held the Hoyt patent in suit invalid under the principle therein stated* (Opinion, Rec. Vol. I, p. 513); but it found *upon the facts* that the McFeely invention was not within that principle.

Petitioner's assertion is that the McFeely patent in suit was essentially a repatenting of an earlier McFeely patent No. 1,129,881, now expired. This, of course, is purely a question of fact and it is a question which was fully considered by the courts below and decided adversely to petitioner. The District Court said (Rec. Vol. I, p. 483):

"While the McFeely patent in suit/ No. 1,558,737, embraces many elements of the McFeely patent No. 1,129,881, the earlier McFeely patent lacked, so far as it relates to Claims 6 and 85, certain elements which prevented it from being commercially successful; that is to say, among others, it would not permit of a successful operation upon a range of shoe sizes; the operation of the tackers and wipers could not be controlled with accuracy, or in other words, adjusted as are the tackers and wipers in the machine covered by the patent in suit; and also, immediately before the tacking movement the wipers would be retracted partly to permit of the tacking and in so doing have a tendency

to pull the upper from the insole, which would tend in some instances to and in many operations did make an imperfect job, if not damage the shoe. This was overcome in the machine covered by the patent in suit by the wipers moving in toward the shoe, holding the upper in place rather than pulling the upper away from the last, prior to the tacking as in the earlier McFeely patent."

The Circuit Court of Appeals said (Rec. Vol. I, p. 504):

"Principally, however, is reliance placed by the appellant upon an earlier patent to McFeely, No. 1,129,881. This is claimed to be a complete anticipation in all essential elements, in manner of their functioning, and in results. It is now expired and the appellant states the fundamental issue here to be whether the appellee may now extend its monopoly by substituting in an old construction equivalent mechanical details also old in the art and so to get a new patent for another 17 years."

(pp. 511-512):

"But to reduce the second McFeely patent to a mere aggregation of tacker and the old form of bed laster or to consider it as merely the combination of the first McFeely patent and conventional expedients for adjustment, is to ignore matters of substance.

"The patent in suit, unlike its predecessor, provides not only for a preliminary adjustment of the wipers but for the maintenance of the tackers in relation thereto. The tacking occurs before the final withdrawal of the wipers, eliminating the tendency to pull the material to be tacked from its wiped position. The heel band of the first McFeely machine was loose and

without support and incapable of sliding movement. Upon the withdrawal of the shoe the heel band was ejected as the result of the release of spring tension upon a plurality of cords. There was absent in the prior McFeely machine, means for adjusting the vertical movement of the hold-down that are present in the patent in suit. *Taken together, the improvements in the second McFeely machine gave a new result and a new unitary mode of operation of the entire machine.* There is here much more than mere improvement in quality or quantity of product due to the independent functioning of an improved element, as in *Bassick v. Hollingshead*, 298 U.S. 415; or *Kodel Elec. Co. v. Warren Clock Co.*, 62 Fed. (2d) 692 (C.C.A. 6).

“The patent in suit is not merely the aggregate of laster and tacker, and the disclosed improvements upon prior art are not limited to the addition of adjustability.”

In an attempt to develop its argument, petitioner misstates at page 2 of its petition the subject matter of the patents in suit. The McFeely patent in suit does not, as petitioner asserts, cover a “bed laster in combination with automatic tackers”. The Circuit Court of Appeals specifically said (Opinion, Rec. Vol. I, p. 511): “The (McFeely) patent in suit is **not** merely the aggregate of laster and tacker.” Nor is the Hoyt patent in suit “for another improved form of combined bed laster and automatic tackers”, as petitioner asserts (p. 2). On the contrary, the Hoyt patent is for a machine for attaching an outsole to a shoe; it is not a lasting machine at all (Hoyt patent, Rec. Vol. II, p. 49-60). The Pym patent covered merely an improvement in machines of the “bed laster” type (Opinion, Rec. Vol. I, p. 504).

The chart on page 2 of the petition for certiorari appears

to imply that merely because several patents have overlapping terms, they also have overlapping subject matter and claims. The error in this implication is too obvious to require comment. Whether there is any overlapping in the subject matter and in the claims of these patents is purely a question of fact which both of the courts below have decided adversely to petitioner.

The improvement effected by the McFeely patent in suit was not, as petitioner repeatedly asserts (Br. pp. 11, 13 and elsewhere), mere adjustability. The contrary was specifically found by the Circuit Court of Appeals (Opinion, Rec. Vol. I, pp. 511-512; *supra*, p. 5):

“... the disclosed improvements upon the prior art are not limited to the addition of adjustability.”

Thus it is evident that any difference of opinion with regard to petitioner's “primary issue” is purely and simply a question of fact.

• ALLEGED “AGGREGATION”.

Petitioner's second alleged reason for granting certiorari in this case is the assertion (Petition, p. 6; Br. p. 19) that the claims in suit are merely for aggregations of old elements or combinations. This is stated by petitioner (Br. p. 19) to be “another form” of petitioner's point I, discussed above.

The Circuit Court of Appeals fully considered this question of fact and said (Rec. Vol. I, pp. 510-511):

“The challenge to the validity of the patent in suit on the ground that it discloses but an aggregation within the principles applied in such cases as *Grinnell v. Johnson Co.*, 247 U.S. 426 (the washing machine and wringer), or *Detroit Stoker Co. v. Brownell*, 89 Fed. (2d) 422 (C.C.A. 6) (the stoker and blower), is not

persuasive. It is true that many of the features of the claims are old and that an organization, including wipers and tackers, was shown in somewhat primitive form in Copeland. It is also true that adjustability of elements, though not in the form shown in the first McFeely patent, is added by the patent in suit to the McFeely type laster, and that mere adjustability by common mechanical expedients may not, of itself, denote the presence of the quality of invention and merit the issue of a patent. *But to reduce the second McFeely patent to a mere aggregation of tacker and the old form of bed laster, or to consider it as merely the combination of the first McFeely patent and conventional expedients for adjustment, is to ignore matters of substance.*

“Taken together, the improvements in the second McFeely machine gave a new result and a new unitary mode of operation of the entire machine.”

Here again, the only questions which petitioner seeks to raise are questions of fact which have been considered by the courts below and decided adversely to petitioner.

“COMMERCIAL SUCCESS OF PRIOR ART.”

Under the above heading petitioner asserts (Petition, p. 6; Br. p. 22) that the Court of Appeals based its holding of validity of the McFeely patent in suit on the fact that this structure was more successful commercially than the earlier McFeely patent.

This is a misrepresentation of the basis of the decision. While the Court below discussed the relative merits of the two structures (Rec. Vol. I, pp. 509-510), it did not base its decision on this comparison, but on the structural differences between the two machines (Rec. Vol. I, pp. 511-512).

"DIVERSITY OF OPINION BELOW."

Under this heading (Petition, p. 6; Br. p. 24) petitioner suggests that the fact that one of the judges of the Circuit Court of Appeals dissented, without opinion, creates a "diversity of opinion". It is a novel idea that a dissent in the court below, particularly a dissent unsupported by any opinion, is ground for the granting of a writ of certiorari.

ALLEGED "PUBLIC IMPORTANCE".

Finally, petitioner asserts (Petition, p. 7; Br. p. 25) that the fact that 1200 of the machines of the McFeely patent in suit are in use, upon which the users are paying rental, makes the case "one of great public importance".

In so far as these machines are held by users under lease, the rentals paid by the lessees are merely ordinary rentals paid for the use of leased property, which will be due, and will continue to be paid, regardless of the existence or validity of any patents on the machines. In so far as the machines have been sold, obviously it makes no difference to their owners whether or not the McFeely patent is valid.

The decision in this case is not of interest to anyone in the country except the parties, because petitioner is the only user in this country of the German machines here found to infringe respondent's patent, and no further machines are now available, or are likely to be available before the patent expires in 1942. In fact, the patent in suit will expire by or about the time a decision could be reached in this case if certiorari were granted.

The petition for certiorari fails to show any reason why this Court should review the decision below. The case presents no conflict of decision, no question of law, and no matter of public importance. What petitioner really seeks by this petition is a third consideration of issues of fact.

which have already been twice decided adversely to it. As this Court said in *Magnum Co. v. Coty*, 262 U.S. 159, 163, "The jurisdiction to bring up cases by certiorari . . . was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

Respectfully submitted,

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